

**REMARKS**

In the Office Action, the Examiner indicated that claims 1 through 39 are pending in the application and the Examiner rejected all claims.

**Claim Rejections, 35 U.S.C. §112**

At item 2 of the Office Action, the Examiner rejected claim 24 under 35 U.S.C. §112, second paragraph. Claim 24 has been amended to make reference to the “generating means” instead of the “routing means”. Applicant submits that this overcomes the rejection under 35 U.S.C. §112, second paragraph. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims under 35 U.S.C. § 112.

**Claim Rejections, 35 U.S.C. §102**

In item 4 on page 2 of the Office Action, the Examiner rejected claims 13, 34 and 39 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,216,122 to Elson ("Elson").

**The Present Invention**

The present invention provides a method in a data processing system for creating rules to process electronic messages. Rather than using prior art methods, whereby rules are input by a user, in accordance with the present invention, when a user is detected moving an email into a folder, characteristics of the email are identified and used to generate a new rule for email in that particular folder. If other messages exist in the folder and the user has selected these other messages, the characteristics of the new message are compared with the other electronic messages in the folder to form a comparison. A rule for processing the electronic

message is then generated based on the comparison. The user is given the ability to accept, reject, or modify the generated rule.

**U.S. Patent No. 6,216,122 to Elson**

U.S. Patent No. 6,216,122 to Elson teaches an electronic mail search folder device. Search attributes that are specified by the user are associated with a mail folder by the invention. Search strings and properties are designated by the user. The user also specifies how often the search should be performed and the folders or objects to search. Upon the occurrence of a specified interval or event, the invention performs the search across the designated folders and objects specified by the user. The invention inserts pointers to the email messages that were found to match the user-specified search criteria into the search folder. Elson thereby provides a flexible, automatic tool for email message organization that does not require users to remember the absolute paths, or locations, of messages.

**U.S. Patent No. 5,978,566 to Plank et al.**

U.S. Patent No. 5,978,566 to Plank et al. teaches the processing in an electronic messaging system of a user-defined rule that specifies a condition and an action to be performed by determining at the server whether the condition is satisfied upon an occurrence of an event. Once the condition is satisfied, the action is performed at the server if all resources for performing the action are resident on the server. Thus, user-specified rules can be performed at the server rather than at the client.

U.S. Patent No. 5,899,995 to Millier et al.

U.S. Patent No. 5,899,995 to Millier et al. teaches an electronic filing system for automatically organizing information to a number of storage elements or folders, such as the storage hierarchy used by Windows® Explorer. In the system of Millier, a user creates a list of constraints and profiles for each folder. The profiles of a folder are the key words or features that characterize the contents of the documents stored in the folder as created by the user. (See column 7, lines 25-40 of Millier.) Once the user has made the list of constraints and profiles (i.e., rules), the system analyzes files and places them into the folders based upon the contents of the file.

The Cited Prior Art Does Not Anticipate the Claimed Invention

The MPEP and case law provide the following definition of anticipation for the purposes of 35 U.S.C. §102:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP §2131 citing *Verdegaal Bros. v. Union Oil Company of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987)

The Examiner Has Not Established a *prima facie* Case of Anticipation

As noted above, the present claimed invention is directed to a method and system for creating rules to process electronic messages (email). Rather than relying upon user input to decide what rule should be applied, the present invention parses the email message and identifies commonality between the email messages. Rules are then generated based on the comparison. See, for example, page 15, lines 18-30. Having the system generate the rules frees the user from having to go through the trouble of identifying which rules to apply and how to have them applied.

None of the references cited by the Examiner teach or suggest these features. Each of them rely upon creation of rules by the user and then application of these rules to existing emails, or, in the case of Millier, files. All of the claims of the present invention are directed to the automatic creation of rules rather than the application of rules created by the user as is done in the prior art. For example, claim 1 is directed to “a method in a data processing system for creating rules to process electronic messages ...” and includes additional elements, such as detection of user input that moves an electronic message into a folder, comparing the characteristics of the electronic message with other electronic messages in the folder to form a comparison, and “generating a rule to process electronic messages based on the comparison”. Each of the independent claims (and thus all dependent claims) include similar limitations. Thus, since none of the references cited by the Examiner teach each and every element of the claimed invention, it is improper to reject the claims under 35 U.S.C. §102 based upon these references.

Accordingly, each of the independent claims, and all claims depending therefrom, patentably define over Elson and are in condition for allowance. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 13, 34 and 39 under 35 U.S.C. §102.

**Rejection of Claims under 35 U.S.C. §103(a)**

At item 6 on page 2 of the Office Action, the Examiner rejected claims 1-4, 6-12, 14-16, 22-24, and 35-38 under 35 U.S.C. §103(a) as being unpatentable over Elson.

At item 7 on page 6 of the Office Action, the Examiner rejected claim 5 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of U.S. Patent No. 5,978,566 to Plank et al.

At item 8 on page 7 of the Office Action, the Examiner rejected claims 12, 17-21, 25, and 27-33 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of U.S. Patent No. 5,899,995 to Millier et al.

At item 9 on page 11 of the Office Action, the Examiner rejected claim 26 under 35 U.S.C. §103(a) as being unpatentable over Elson and further in view of Millier et al. and Plank et al.

**The Examiner has not Established a *prima facie* Case of Obviousness**

As set forth in the MPEP:

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skilled in the art, to modify the reference or to combine reference teachings.

**MPEP 2143**

As noted above, none of the references teach the automatic generation of rules for electronic messages. Likewise, none of these references suggest modifying their disclosure to achieve these claimed elements. Accordingly, it is improper to reject the claims under 35 U.S.C. §103 in view of the cited references. In fact, there is no discussion whatsoever of a system that generates rules for application to email messages. Accordingly, each of the claims patentably define over the references cited by the Examiner both alone and in combination. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1-12, 14-33, and 35-38 under 35 U.S.C. §103.

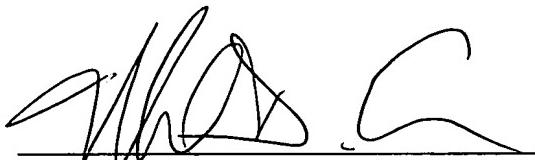
Conclusion

The present invention is not taught or suggested by the prior art. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the rejection of the claims. An early Notice of Allowance is earnestly solicited.

The Commissioner is hereby authorized to charge any fees associated with this communication to Deposit Account No. 19-5425.

Respectfully submitted

July 9, 2003  
Date



Mark D. Simpson, Esquire  
Registration No. 32,942

SYNNESTVEDT & LECHNER LLP  
2600 ARAMARK Tower  
1101 Market Street  
Philadelphia, PA 19107

Telephone: (215) 923-4466  
Facsimile: (215) 923-2189